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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,800	11/23/1999	F. RICHARD BRINGHURST	0609.4630001	4272

7590 04/10/2002

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EXAMINER

WEGERT, SANDRA L

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 04/10/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/447,800

Applicant(s)

BRINGHURST ET AL.

Examiner

Sandra Wegert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-6, 8 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 is/are rejected.
- 7) ☒ Claim(s) 5, 6 and 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

#### ***Status of Application, Amendments, and/or Claims***

The amendment filed 24 January 2002 (Paper No. 14) has been entered. Claims 1, 7 and 9-29 were cancelled. Claims 3 and 4 were withdrawn by the examiner.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2, 5, 6 and 8 are currently under examination.

#### **Withdrawn Objections and/or Rejections**

#### ***Abstract***

The objection to the Abstract of the disclosure for not being of narrative form (Paper 13, 1/24/01) is *withdrawn* by the examiner in view of the corrected Abstract presented by Applicant (Amendment B, 1/24/02). See MPEP § 608.01(b).

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**35 USC § 101, - non-statutory**

The rejection of Claims 1, 2 and 5-8 under 35 U.S.C. 101 (Paper 13, 1/24/01) because the claimed invention was directed to non-statutory subject matter (i.e., "product of nature"), is *withdrawn* in view of the Amendment by Applicant (Amendment B, 1/24/02) that inserted language such as "isolated" or "recombinant" into relevant claims.

**Claim Rejections - 35 USC § 112, second paragraph - Indefiniteness**

The rejection of claim 1 under 35 U.S.C. 112, second paragraph, as being indefinite (Paper 13, 1/24/01, p. 4) is withdrawn in view of cancellation of the claim by Applicant (Amendment B, 1/24/02).

**35 USC § 112, first paragraph - scope**

The rejection of claims 1, 2 and 5-8 under 35 U.S.C. 112, first paragraph (Paper 13, 1/24/01, p. 4-6) for not enabling all variants of the claimed polypeptides, is *withdrawn* in view of the cancelled claims and the explanation by Applicant (Amendment B, 1/24/02, p. 7).

**Claim Rejections - 35 USC § 102**

The rejection of claims 1, 2 and 5-8 (Paper 13, 1/24/01, p. 7-8) under 35 U.S.C. 102(b) as being unpatentable over Toyo, et al, 1983 (Japanese Patent 58-96052) is *withdrawn* in view of the cancelled claims (Amendment B, 1/24/02, p. 9).

The rejection of claims 1, 2 and 5-8 under 35 U.S.C. 102(b), (Paper 13, 1/24/01, p. 7-8) as being unpatentable over Rosenblatt, et al, 1983 (US Patent 4,423,037) is *withdrawn* in view of

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the amendment canceling claims 1 and 7, and in view of the explanation by Applicant (Amendment B, 1/24/02, p. 10).

The rejection of claims 1, 2 and 5-8 (Paper 13, 1/24/01, p. 7-8) under 35 U.S.C. 102(b) as being unpatentable over Japanese Patent 59-204159 (Daicel Chem. Ind., 1984) is *withdrawn* in view of the amendment canceling claims 1 and 7, and in view of the explanation by Applicant (Amendment B, 1/24/02, p. 10).

The rejection of claims 1, 2 and 5-8 (Paper 13, 1/24/01, p. 7-8) under 35 U.S.C. 102(b) as being unpatentable over Neer, et al, 1987 (US Patent 4,698,328) ) is *withdrawn* in view of the amendment canceling claims 1 and 7, and in view of the explanation by Applicant (Amendment B, 1/24/02, p. 10).

**Maintained Rejections/Objections**

**Objections/Informalities:**

***Figures***

The drawings remain objected to for reasons illustrated in Form PTO 948 (10/24/01, Paper 13). Corrections will be required in the event any claims are allowable.

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***Sequence Rules***

The objection to the Specification, in particular the drawings, for lacking compliance with the sequence rules, 37 CFR 1.821-1.825, especially 1.821, part (c), is *maintained*. Each disclosure of a sequence embraced by the definitions set forth in the rules must be accompanied by the required reference to a unique sequence identifier (i.e., SEQ ID NO:). This occurs in Figs. 1-6, for example (e.g., *hPTH1-34*). Sequence identifiers for a Figure may be placed in the Figure itself or in the Brief Description of the Drawings corresponding to that figure.

***Claim Rejections - 35 USC § 112, second paragraph***

The rejection of claim 2 under 35 U.S.C. 112, second paragraph, as being indefinite (Paper 13, 1/24/01, p. 7), is *maintained*.

Claim 2 is vague and indefinite because the claim recites a peptide with "X<sub>01</sub>" [as] "desamino Ser" and in the same claim requires that the peptide is "*not* desamino Ser<sup>1</sup>hPTH(1-34)NH<sub>2</sub>". Clarifying language that defined the difference between "Ser<sup>1</sup>" and "Ser" might be remedial.

Conclusion: Claim 2 is rejected. Claims 5, 6 and 8 are objected to for depending from a rejected base claim, but would be allowable if written in independent form.

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***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Wegert whose telephone number is (703) 308-9346. The examiner can normally be reached Monday - Friday from 9:30 AM to 5:00 PM (Eastern Time). If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached at (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

SLW

4/6/02

*Gary L. Kunz*  
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